

REMARKS

Claims 17-59 are pending in the application. Claims 34-46 and 55-59 are allowed. Reconsideration and withdrawal of the remaining rejections are requested in view of the following remarks.

Turning to the § 102(f) rejections at Section 2 of the Final Office Action, enclosed is an updated, more detailed Rule 1.132 declaration by Hisashi Higuchi, a named inventor in the two cited Shibata et al. design patents, but not in the pending utility application. The new Rule 1.132 declaration explains in detail how Mr. Higuchi contributed only to the ornamental features of the design embodiments, and not to the utilitarian features recited in the claims of the utility application.

Page 2 of the declaration, for example, explains that Mr. Higuchi "joined the project at the point where Mr. Shibata and Mr. Masuda had completed the basic design of a rear mounted battery powered table saw." Mr. Higuchi goes on to state, "Since the basic design work was completed at this time, I was focused on the unification of the design between the battery powered table saw without a sliding mechanism and a battery powered table saw with a sliding mechanism" (i.e., on elements that are not recited in the utility claims).

Page 3 of the declaration further explains that Mr. Higuchi "did not take part in developing the subject matter of the invention claimed in Application No. 09/350,297, including but not limited to mounting the battery to the handle near the switch to operate the motor, using the battery as a counter-weight to the saw unit, transmitting the rotation of the motor via a driving belt, incorporating a battery case, or mounting the battery to one of the auxiliary tables." Accordingly, Hisashi Higuchi was properly not included as an inventor in the current case, as he did not contribute to the utilitarian

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aspects of the claimed invention. The named inventors, therefore, did indeed invent the claimed subject matter, and the Applicants therefore submit that the §102(f) rejections have been overcome.

With respect to the § 102(f) and (g) rejections at Section 3 of the Office Action, the Examiner intimated, in the Response to Arguments section of the 7/14/04 Office Action, that these rejections would be removed upon receipt of a detailed Rule 1.132 declaration by Hisashi Higuchi, which is now included with this response. Additionally, with respect to the § 102(g) "same invention" rejections, the pending claims and the design patent claims are not the same as one another, as explained in detail in the Applicants' 2/19/04 response. The Examiner acknowledged, at page 5 of the 7/14/04 Office Action, that the Applicants' explanation with regard to the § 102(g) rejections was convincing. Furthermore, no mention was made of the Applicant's arguments regarding the § 102(g) rejections in the Response to Amendment section of the current Office Action. Thus, the Applicants assume that the § 102(g) rejections were inadvertently included in the current Office Action.

To reiterate the Applicants' position with respect to the § 102(g) rejections, however, Applicants submit that none of the rejected claims are directed to the same invention as either of the inventions claimed in the cited Shibata et al. design patents. First, several elements shown in the design patents are not recited in the utility claims. For example, rejected claims 17 and 47 do not recite the link mechanisms, saw arm structures, etc. that are shown in the design patents. Claim 17 also does not recite the saw handle, or the handle location, as shown in the design patents. Claim 47 does not recite a battery, a motor, etc.

In other words, several of the elements shown in each of the design patents are not recited in the rejected utility claims, and the claimed designs therefore cannot be recreated from the rejected utility claims. Accordingly, the rejected utility claims are not directed to the "same" invention as either of the cited design patents. Furthermore, a hypothetical miter saw having a different ornamental design than either of those shown in the Shibata et al. design patents could literally infringe one or more of the rejected utility claims, but neither of the design claims. Thus, none of the utility claims are the "same" as either of the design claims.

Indeed, the cited design patents and the pending utility claims do not satisfy the "two-way" same patentable invention test, which requires that a claimed invention A must anticipate or make obvious a claimed invention B, and that the claimed invention B must anticipate or make obvious the claimed invention A, thereby meeting both prongs of the "two-way" test for a same invention. *Noelle v. Lederman*, 335 F.3d 1343, 1351, 69 USPQ2d 1508, 1515 (Fed. Cir. 2004). Thus, to compare two inventions, only the claims of the inventions should be compared. *Noelle*, 335 F.3d at 1352, 69 USPQ2d at 1516. As explained above, the cited design patents include several features not recited in the pending utility claims, and are at best non-obvious species of the broader utility claims. The inventions claimed in the design patents, therefore, are clearly not the "same" as the invention recited in the pending utility claims.

Furthermore, the two design patents themselves are directed to two separate and different inventive designs. Accordingly, none of the individual rejected utility claims can be the "same" as both design claims, which are not the same as one another. Moreover, rejected independent claims 17 and 47 each recite different structures, and therefore cannot be the "same" as one another. For example, claim 47

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recites a handle, which claim 17 does not recite. Similarly, claim 47 does not recite several of the elements recited in claim 17. Thus, claims 17 and 47 are not the same as each other, the two Shibata et al. design claims are not the same as each other, and no single utility claim can logically be the same as both of the design claims. Thus, none of the utility claims are the same as either of the Shibata et al. design claims. Accordingly, the Applicants submit that the § 102(g) rejections have been overcome.

In view of the foregoing, it is submitted that the claims are in condition for allowance, and a Notice of Allowance is requested.

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Respectfully submitted,

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